REMARKS

Entry of this Amendment, and reconsideration and withdrawal of all grounds of rejection are respectfully requested in light of the above amendments and the following remarks. Claims 1-20 remain pending herein. Claims 1,11, 15 and 18 have been amended hereby.

Summary of the Rejections:

(1) Claims 1-2, 4,6-7, 9-11, 13,15 and 18-20 stand rejected under 35 U.S.C§103(a) as allegedly being unpatentable over Kamaya et al. (U.S. 5,537,175 hereafter "Kamaya")in view of Ueda et al. (U.S. 4,560,261 hereafter "Ueda").

(2) Claim 3 stands rejected under 35 U.S.C.§103(a) over Kamaya in view of Ueda and further in view of Braun (U.S. 5,532,737).

(3) Claims 5 and 12 stand rejected under 35 U.S.C.§103(a) as allegedly being unpatentable over Kamaya in view of Ueda and further in view of Kakii (U.S. 6,137,526).

(4) Claim 8 stands rejected under 35 U.S.C.§103(a) as allegedly unpatentable over Kamaya in view of Ueda and further in view of Kawashima et al. (U.S. 6,079,862 hereafter "Kawashima").

Applicants Traversal:

Applicants have amended base claims 1 and 15 to recite, *inter alia,* that the mirror has a transparent area to permit the camera to capture the camera image. Support is found in the specification at least at page 3, lines 20-21. As the Applicants teach in the

same paragraph providing support that different applications will require different light detecting ability from the camera. This claimed element is distinguishable from Kamaya, which sticks a two-way mirror (aka half mirror) on the lens. The combinations of Kamaya and Ueda, and/or Braun, Kakii, or Kawashima, fail to obviate the claimed invention, as the combinations of references fail to disclose, suggest or provide an artisan with motivation to make modifications such that the instant claims would have been obvious to the artisan.

Applicants respectfully submit that the side of a two way mirror (such as disclosed by Kamaya) in which one can view objects on the other side is anything but transparent, particularly because the image of the person and/or whatever is in the room to a certain degree hinders the camera from recording a true image. However, a transparent area in the mirror, as presently claimed, overcomes problems associated with lighting (as a two-way or half mirror would capture a much darker image) and capture an image of the person that is more accurate than an camera having its view obstructed in part by a two-way or half mirror.

For at least the above reasons, it is respectfully submitted that instant claims 1 and 15, as well as all of those claims dependent therefrom, are patentable over any combination of the cited references. The dependent claims have a separate basis for patentability, but in lieu of the amendment to claims 1 and 15, they are allowable at least for their dependency upon what is believed to be allowable base claims.

In addition, base claims 11 and 18 have been amended to recite that the mirror is attached to an exterior of the camera. Support for this change is found in the specification at least at page 6, lines 27-29, and one example is shown in Fig. 8a. It is

respectfully submitted that the combinations of references fails to disclose or suggest this claimed feature, for example, as Ueda, for example, discloses a mirror embedded in the front surface of the camera, and Kamaya merely places a two-way mirror sticker (aka half mirror) on the lens. The attachment of the mirror to the body of the camera allows it to be an inexpensive accessory that can be added to almost any camera. It is respectfully submitted that the combination of references fails to disclose, suggest, or provide motivation regarding this claimed feature.

Accordingly, it is respectfully submitted that base claims 11 and 18 are patentable for the reasons indicated. All of the claims dependent from these two base claims are also patentable at least because of dependence on their base claims, and for different reasons of patentability.

It is respectfully submitted that in light of the foregoing amendments and comments, all grounds of rejection have been overcome. With regard to rejection under 35 U.S.C.§103(a), Applicants respectfully submit that the Court of Appeals for Federal Circuit has held that:

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the reference or in the knowledge in the art, to modify the reference. Second there must be a reasonable expectation of success. Third, the prior art reference must teach or suggest all the claim limitations. As held by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), the long-standing principle was affirmed that the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure.

Furthermore, the Court of Appeals has also held that:

> Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

It is respectfully submitted that in the present case, there is no disclosure. suggestion, or motivation to modify the combination of references such that the instant claims would have been obvious to an artisan at the time of invention.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Tony Piotrowski
Registration No. 42,080

Date: June 11, 2003 By: Steve Cha
Attorney for Applicant
Registration No. 44,069

Mail all correspondence to:
Tony Piotrowski, Registration No. 42,080
US PHILIPS CORPORATION
580 White Plains Road
Tarrytown, NY 10591
Phone: (914) 333-9624
Fax: (914) 332-0615

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Steve Cha, Reg. No. 44,069
(Name of Registered Rep.)

6/11/03
(Signature and Date)